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In re Application of  
Van der Laan et al.  
Application No. 07/565,673  
Filed: August 10, 1990  
Attorney Docket No. GC329-US3

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**ON PETITION**

This is a decision on the petition under 37 CFR 1.137(b), filed December 23, 1998, to revive the above-identified application. This is also a decision on the petitions filed the same date under 37 CFR 1.183 requesting waiver of the rules and acceptance of a submission under 37 CFR 1.129(a), as well as waiver of the petition fees and requirement for a terminal disclaimer..

The petitions under 37 CFR 1.137(b) to revive, and under § 1.183 requesting waiver of 37 CFR 1.129(a) are **GRANTED**.

The petitions under 37 CFR 1.183 requesting waiver of the petition fees and requirement for a terminal disclaimer are **DISMISSED**.

The Terminal Disclaimer filed December 23, 1998 has been accepted. The period disclaimed is thirteen (13) months, which is equivalent to the period of abandonment, which began December 7, 1997, and ended with the filing of the grantable petition on December 23, 1998.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Since the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

*With respect to the issue, and date, of abandonment:*

Contrary to the assertion in the petition, and for the reasons explained in more detail below, the above-identified application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 1.17(c)) within the time period provided in 37 CFR 1.192(a). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed October 6, 1997, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.192(b) & 1.197(c). As no claim was allowed, the above-identified application became abandoned on December 7, 1997. See MPEP 1215.04. A Notice of Abandonment has not been mailed.

Petitioner asserts that the application became abandoned October 16, 1995 due to an inadvertent filing of a submission under 37 CFR 1.129, in that as a Brief on Appeal had been previously filed, 37 CFR 1.129(a) was, by its terms, not an available medium for continuing prosecution. Petitioner also seeks waiver, *inter alia*, of the associated petition fees, requirement for a terminal disclaimer, and waiver of 37 CFR 1.129 such that an accompanying submission thereunder be accepted.

Inspection of the record reveals that petitioner is correct that, as a Brief on Appeal had been filed March 7, 1994, the submission of October 20, 1995 could not have been treated by the examiner under 37 CFR 1.129(a), as the examiner has not been delegated the authority to waive any requirement of the rules of practice. Rather, that authority rests with the Special Programs Law Office/Office of Petitions. See MPEP 1002.02(b), ¶ 2.

Nevertheless, the examiner does have the authority to withdraw a final rejection, see MPEP 706.07(e), and reopen prosecution, so long as the application is pending at that time. See Lorenz v. Finkl, 333 F.2d 885, 891, 142 USPQ 26, 30 (CCPA 1964) (an examiner has no procedural authority with respect to an abandoned application).

It is pointed out that the submission of October 20, 1995 was filed subsequent to the Notice of Appeal of August 18, 1995, which set a two month period for reply under 37 CFR 1.192(a), that was extendible until February 18, 1996 pursuant to 37 CFR 1.191(d), and 37 CFR 1.136(a) in effect at that time.<sup>1</sup> As such, and considered in a light most favorable to applicants, the submission under 37 CFR 1.129 was also treatable by the examiner as an amendment under 37 CFR 1.116. See MPEP 1207. Inspection of PTO financial records reveals that former counsel's deposit account was twice charged \$750 for treating the submission under 37 CFR

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<sup>1</sup> Effective December 1, 1997, the period for maintaining pendency after the filing of a Notice of Appeal is extendible under 37 CFR 1.136(a) for an additional five months.

1.129(a).. As such were fees paid by error under 37 CFR 1.129(a) , for the reasons noted above, petitioner should alert former counsel that he may request a refund in writing, to the Office of Finance, Refunds Section, and enclose a copy of this decision with the request.

It is further noted that both the Notice of Appeal transmittal letter, as well as the submission itself, contained conditional petitions for such extension of time as necessary, and authorized the charging of the requisite fees, and, as such, the submission was properly considered by the examiner after the final rejection. See MPEP 706.07(g), ¶ L; MPEP 710.02(e). Since the Office action of January 18, 1996, which considered the submission after final rejection, was mailed within the extendible period for reply (the fifth month), the PTO should have then also charged the necessary three month extension fee (then, \$870) to maintain the pendency of the application.

That fee has now been charged to deposit account No. 07-1048.

*With respect to the requested waivers:*

Petitioner's request for waiver of the petition fees cannot be granted as the petition fees are required by statute upon the filing of the petition and the PTO has no authority or discretion to waive a statutory requirement. See 37 CFR 1.183.

Section 711.03 of the Manual of Patent Examining Procedure (MPEP) provides, in part, that

In addition, the phrase "[o]n filing" in 35 U.S.C. 41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), reprinted in 1982 U.S.C.C.A.N. 770 ("[t]he fees set forth in this section are due on filing the petition"). Therefore, the Office: (1) will not refund the petition fee required by 37 CFR 1.17(l) or 1.17(m), regardless of whether the petition under 37 CFR 1.137 is dismissed or denied; and (2) will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee.

See MPEP 711.03(c)(III)(B)(7th. ed. 1998). Accordingly, the petition for waiver of the petition fees is **dismissed**.

Petitioner's request for waiver of the requirement of 37 CFR 1.137(c) for a terminal disclaimer is predicated upon the circumstances surrounding petitioner's erroneous assumption that the application became abandoned in 1995, due, in part, to petitioner's detrimental reliance upon PTO acceptance of the submission under 37 CFR 1.129(a). Since, as noted above, the application became abandoned December 7, 1997 for failure to file an appeal brief, the arguments do not warrant waiver of the requirement of a terminal disclaimer, in that the thirteen month delay in prosecution after December 7, 1997 is strictly due to petitioner's failure to timely

file a Brief on Appeal as part of petitioner's self imposed obligation created by petitioner's filing of the Notice of Appeal on October 6, 1997. See MPEP 711.03(c).

Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983). Thus, there is no adequate showing of "an extraordinary situation" in which "justice requires" suspension of 37 CFR 1.137(c). See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers). Circumstances resulting from petitioner's failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977). Accordingly, the petition for waiver of the requirement of 37 CFR 1.137(c) is **dismissed**.

However, under the circumstances of this case, it is agreed that the interests of justice would best be served by waiving the prohibition in 37 CFR 1.129(a) from accepting a submission under 37 CFR 1.129(a) filed subsequent to the filing of a Brief on Appeal, as the proposed reply to continue prosecution. Accordingly the petition for waiver of 37 CFR 1.129(a) is **granted**. Should petitioner file a second submission in this case, a further petition for waiver will not be required. No submissions under 37 CFR 1.129(a) filed subsequent to any forthcoming second submission are, or will be, authorized.

Fees totaling \$1410 (\$870 for the three month extension of time owed January 18, 1996, and \$540 for three petitions under 37 CFR 1.183) have been charged to deposit account No. 07-1048.

The application file is being forwarded to Technology Center AU 1643 for consideration of the submission under 37 CFR 1.129(a) filed December 23, 1998.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-1820.



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